

Remarks

The claims were amended in accordance with the amendments above. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

§102 Rejections

In the Office Action dated 01/25/2008, claims 1-2 and 6 were rejected under 35 U.S.C. §102(e) as being unpatentable over Carney (U.S. 6,408,278). Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant submits that Carney fails to teach or suggest all of the limitations recited in amended independent claim 1, particularly in the arrangement required by the claim. For instance, amended independent claim 1 recites “the advertisements on the displays being configured to promote a product offered for sale by the participating merchants, wherein each advertisement comprises product information related to the product and a unique product order number associated with the product offered for sale in the advertisement.” The Office argued that Carney discloses the use of a unique product order number by stating “the user uses gathering device 32b to order products or services advertised” (See Office Action dated 08/27/2008, p. 3). Even if one assumes that Carney discloses a gathering device to order products or services, as the Office claims, that still does not teach or suggest the inclusion of a unique product order number in the advertisements as recited in claim 1. As described in Carney, the purpose of data gathering device 32b is “to collect data regarding the demographics and so on” (Carney, col. 6, lines 54-55). Examples of types of gathering devices include a kiosk with internet access, a camera, shopping bags, and a free or fee-reduced ATM (See Carney col. 6, line 56 – col. 7, line 2). Nowhere in the discussion of these devices does Carney discuss the content of the advertisements being displayed, let alone disclose the use of a unique product order number as recited in amended claim 1.

In addition, Applicant respectfully asserts that Carney fails to disclose an order processing system as recited in amended claim 1. The Office argued that Carney does disclose the order processing system recited in claim 1 by pointing to Figure 6 (See Office Action dated 08/27/2008, p. 3). However, Applicant respectfully points out that Figure 6 depicts an advertising system where the server is coupled with a client's inventory system in order to "automatically advertise (or recommend advertising) a product, or products, whenever inventory of that product reaches an unsatisfactory level" (Carney, col. 8, lines 27-28). Figure 6 and the accompanying description (See Carney, col. 7, line 64 – col. 8 line 28) do not provide any details at all regarding an order processing system or any interaction between a purchaser and the system. Although Carney briefly mentions the use of a kiosk to access an on-line store and purchase the product or service (See Carney, col. 7, lines 16-17), this brief discussion does not describe any of the details of the order processing system recited in claim 1, including, among others, "a customer interface for receiving incoming orders from customers of the merchants ordering products *by reference to the displayed product order numbers.*" (emphasis added). Consequently, Carney fails to teach or suggest such limitations, among others, particularly in the arrangement required by claim 1. Accordingly, Carney fails to anticipate claim 1 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Amended independent claim 6 recites "including in the advertisements a unique product order number associated with each product offered for sale by the participating merchants, wherein the unique product order number is further associated with the participating merchant responsible for fulfilling orders for the product associated with the unique product number" and "matching the product order number supplied by the customer of the merchant with the associated product and the associated participating merchant responsible for fulfilling orders for the product." As discussed above with regard to amended claim 1, the Office previously argued that Carney disclosed the inclusion of a unique product order number in the advertisements by pointing to the use of gathering device 32b to order advertised products or services as teaching the use of a unique product order number (See Office Action dated 08/27/2008, p. 3). Applicant respectfully submits that neither the description of gathering device 32b, nor any other portion of Carney, discloses the incorporation of a unique product number associated with *both* the product and the participating merchant. In fact, Applicant submits that Carney does not discuss the content of the advertisements at all.

In addition, Applicant respectfully asserts that Carney fails to disclose a “central order processing system matching the product order number supplied by the customer of the merchant with the associated product and the associated participating merchant responsible for fulfilling orders for the product,” as recited in amended claim 6. The brief discussion of ordering products or services on-line via a nearby kiosk (See Carney, col. 7, lines 16-17) does not describe how the orders are processed or fulfilled. Accordingly, Carney fails to anticipate amended claim 6 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty.

§103 Rejections

Claims 3-5 and 7 were rejected under 35 U.S.C. §103(a) as being obvious over Carney. Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the Office must give due consideration to all of the limitations of a claim. The Office must also sufficiently establish a motivation to combine or modify the teachings of the prior art in order to reach a claimed invention in accordance with MPEP 2143.01. Obviousness rejections “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of the present claims obvious.

As noted above with respect to the §102 rejections, Carney fails to teach all of the limitations of amended claim 1. The Office has not cited any other prior art reference that makes up for such deficiency of Carney. The combined art of record therefore fails to render amended claim 1 obvious in accordance with MPEP 2143.01. Furthermore, the Office has not provided articulated reasoning with some rational underpinning, beyond merely conclusory assertions, that would support an obviousness rejection of amended claim 1 in accordance with MPEP 2143.03. Because claims 3-5 depend from amended claim 1, and include additional limitations, the

combined art of record also fails to render any of claims 3-5 obvious in accordance with MPEP 2143. Applicant therefore respectfully requests that the rejections be withdrawn.

Similarly, the Office has not cited any prior art reference that makes up for the deficiency of Carney noted above with respect to amended claim 6. The combined art of record therefore fails to render amended claim 6 obvious in accordance with MPEP 2143.01. Furthermore, the Office has not provided articulated reasoning with some rational underpinning, beyond merely conclusory assertions, that would support an obviousness rejection of amended claim 6 in accordance with MPEP 2143.03. Because claim 7 depends from amended claim 6, and includes additional limitations, the combined art of record also fails to render claim 7 obvious in accordance with MPEP 2143. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

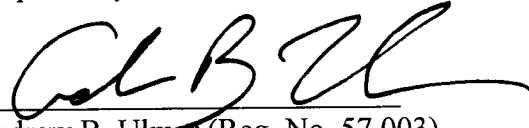
Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513)369-4811 or via e-mail at aulmer@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A. B. Ulmer', written over a horizontal line.

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